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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,005	12/05/2001	James Burke	4851.01	2854

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EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2626

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/002,005	BURKE, JAMES	
	<b>Examiner</b>	<b>Art Unit</b>	
	Beniyam Menberu	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3, 12 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 11, 13-15, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 7-10, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### ***Response to Arguments***

1. Applicant's arguments, see Remarks pages 11-23, filed September 13, 2005, with respect to the rejection(s) of claim(s) 1, 11, and 15 under U.S. Patent No. 5764371 to Kawashima et al have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. 2002/0087861 A1 to Segev et al.

### ***Claim Objections***

2. Claim 2 from the Amendment to the Claims is not the same as claim 2 in the original claim even though Claim 2 in the Amendment to the Claims is described as "Previously Presented".

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 6, 11, 13, 14, 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5764371 to Kawashima et al in view of U.S. Patent No. 5867586 to Liang further in view of U.S. Patent Application Publication No. U.S. 2002/0087861 A1 to Segev et al.

Regarding claim 1, Kawashima et al disclose a confirming facsimile (FAX) machine comprising:

means for scanning and sending each page of a document electronically to a receiving FAX machine (column 6, lines 33-43);

means for marking each page of a document scanned and sent by said FAX machine with an ink message (column 2, lines 46-48; column 8, lines 53-61),

means for reading said marking to confirm the scanning and sending of each page of said document (column 2, lines 34-43). However Kawashima et al does not disclose

a) wherein the ink message being printed with an invisible ink which is only visible in the ultra violet (UV) spectrum; and

b) means for reading said marking to confirm the scanning and sending of each page of said document;

c) wherein said FAX machine is configured to confirm that each page of a document has been scanned and sent by said FAX machine to a particular receiving FAX machine at a particular time and date.

Liang et al disclose wherein the ink message being printed with an invisible ink which is only visible in the ultra violet (UV) spectrum; and means for reading said marking to confirm the scanning and sending of each page of said document (column 4, lines 20-30; Figure 1, reference 10; column 5, lines 51-55).

Segev et al disclose wherein said FAX machine is configured to confirm that each page of a document has been scanned and sent by said FAX machine to a

particular receiving FAX machine at a particular time and date (paragraph 216, 223, 238, 239(lines 5-7), 240).

Kawashima et al, Liang et al, and Segev et al are combinable because they are in the similar problem area of marking documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the invisible markings of Liang et al with the time and destination information stamping of Segev et al to implement time/destination stamping of communication documents with invisible ink.

The motivation to combine the reference is clear because Liang teaches that for security purpose special markings are needed (Liang et al: column 1, lines 53-67) and date and destination markings can be useful for organization purpose for transmission of documents by facsimile and also for proof (Segev et al: paragraph 139).

Regarding claim 5, Kawashima et al in view of Liang further in view of Segev et al teach all the limitations of claim 1. Further Kawashima et al in view of Liang further in view of Segev discloses confirming FAX machine of claim 1, wherein said marking means is a printer (Kawashima et al: column 6, lines 17-25) for marking data including date, time the FAX is sent, and telephone number to which the FAX is sent (paragraph 164, 216, 223, 238, 240).

Regarding claim 11, Kawashima et al disclose a method of confirming the scanning and sending of each page of a document by a facsimile (FAX) machine, said method comprising:

Art Unit: 2626

scanning and sending each page of the document by the FAX machine (column 6, lines 33-43);

reading said marking to confirm the scanning and sending of each page of the document (column 2, lines 34-43). However Kawashima et al does not disclose a method of

a) marking each page of the document with invisible ink which is only visible in the ultra violet (UV) spectrum;

b) confirming that each page of the document has been scanned and sent by the FAX machine to a particular receiving FAX machine at a particular time and date.

Liang et al disclose marking each page of the document with invisible ink which is only visible in the ultra violet (UV) spectrum (column 4, lines 20-30; Figure 1, reference 10; column 5, lines 51-55).

Segev et al disclose confirming that each page of the document has been scanned and sent by the FAX machine to a particular receiving FAX machine at a particular time and date (paragraph 216, 223, 238, 240).

Kawashima et al, Liang et al, and Segev et al are combinable because they are in the similar problem area of marking documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the invisible markings of Liang et al with the time and destination information stamping of Segev et al to implement time/destination stamping of communication documents with invisible ink.

The motivation to combine the reference is clear because Liang teaches that for security purpose special markings are needed (Liang et al: column 1, lines 53-67) and date and destination markings can be useful for organization purpose for transmission of documents by facsimile and also for proof (Segev et al: paragraph 139).

Regarding claim 13, Kawashima et al in view of Liang further in view of Segev et al teach all the limitations of claim 11. Kawashima et al disclose the method of confirming that said page was scanned and sent (column 2, lines 34-43) and Liang discloses the method further comprising the step of reading each marking under a UV lamp (Figure 1, reference 10; column 5, lines 51-55).

Regarding claim 14, Kawashima et al in view of Liang further in view of Segev et al teach all the limitations of claim 11. The method of claim 11, wherein said mark includes the time, the date and the FAX number to which the document is sent (Segev et al: paragraph 216, 223, 238, 240).

Regarding claim 15, Kawashima et al disclose a facsimile (FAX) confirmation device comprising:  
means for marking each page of a document scanned and sent by a FAX machine with an ink message (column 2, lines 46-48; column 8, lines 53-61),  
means for reading said marking to confirm the scanning and sending of each page of the document (column 2, lines 34-43),  
wherein said FAX confirmation device is configured to be attached with a FAX machine at a point past the output of a scanner of said FAX machine (Figure 4, reference 10a,

10b; column 6, lines 17-25). However Kawashima et al does not disclose a facsimile (FAX) confirmation device wherein:

the ink message being printed with an invisible ink which is only visible in the ultra violet (UV) spectrum; and

means for reading said marking to confirm the scanning and sending of each page of the document to a particular receiving FAX machine at a particular time and date,

Liang et al disclose wherein the ink message being printed with an invisible ink which is only visible in the ultra-violet (UV) spectrum (column 4, lines 20-30; Figure 1, reference 10; column 5, lines 51-55).

Segev et al disclose wherein marking is used to confirm the scanning and sending of each page of the document to a particular receiving FAX machine at a particular time and date (paragraph 216, 223, 238, 240).

Kawashima et al, Liang et al, and Segev et al are combinable because they are in the similar problem area of marking documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the invisible markings of Liang et al with the time and destination information stamping of Segev et al to implement time/destination stamping of communication documents with invisible ink.

The motivation to combine the reference is clear because Liang teaches that for security purpose special markings are needed (Liang et al: column 1, lines 53-67) and date and destination markings can be useful for organization purpose for transmission of documents by facsimile and also for proof (Segev et al: paragraph 139).



Regarding claim 19, Kawashima et al in view of Liang further in view of Segev et al teach all the limitations of claim 15. Further Segev et al disclose the FAX confirmation device of claim 15, wherein said marking means is a printer for marking data including date, time each page of the document is sent, and telephone number to which each page of the document is sent (Segev et al: paragraph 120, 216, 223, 238, 240).

Regarding claims 6 and 20, Kawashima et al in view of Liang further in view of Segev et al teach all the limitations of claims 5 and 19 respectively. Further Kawashima et al in view of Liang further in view of Segev et al disclose a confirming FAX machine or device, further comprising a printer controller for receiving electrical signals (Kawashima et al: column 3, lines 20-25) representing time, date, and FAX number from said FAX machine (Segev et al: paragraph 240, 140) and controls said printer by sending corresponding electrical control signals to said printer (Control signals are inherent to a printing device.).

#### ***Allowable Subject Matter***

5. Claims 2, 4, 7-10, 17, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2626

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

Should you have questions on access to the Private PAIR system, contact the

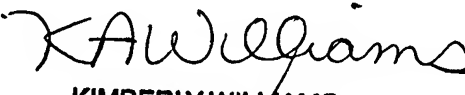
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***Patent Examiner***

Beniyam Menberu

BM

12/19/2005

  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER